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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC C. HANNAH and MICHAEL BOYD

Appeal 2008-0883
Application 09/690,512
Technology Center 3600

Decided: April 14, 2008

Before HUBERT C. LORIN, LINDA E. HORNER, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

HORNER, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

Eric C. Hannah and Michael Boyd (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-7, 9, 11-17, 19, and 21-30, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is to a way to ensure that advertising material inserted in content is actually played as originally designed and intended by the advertiser (Spec. 2: 3-5). Claims 1, 5, and 21, reproduced below, are representative of the subject matter on appeal.

> 1. A method comprising:
>
> monitoring a watermark included with an advertisement;
>
> accruing a credit after determining that the advertisement was played; and
>
> associating an indication that an advertisement was played with an identifier for a particular user.
>
> 5. The method of claim 1 wherein monitoring the watermark includes determining that the advertisement was played at a predetermined speed.
>
> 21. A system comprising:
>
> a processor-based device;
>
> a media player coupled to said processor-based device; and

> a watermark detector coupled to said media player, said watermark detector to detect a watermark included with an advertisement and to control operation of said media player in response to detection of the watermark.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Rodriguez	US 6,650,761 B1	Nov. 18, 2003

The following rejections are before us for review:

1. Claims 5, 15, and 25 are rejected under 35 U.S.C. § 112, second paragraph, for failing to point out and distinctly claim the subject matter of the invention.
2. Claims 1-7, 9, 11-17, 19, and 21-30 are rejected under 35 U.S.C. § 102(e) as anticipated by Rodriguez.

ISSUES

The Examiner found that claims 5, 15, and 25 are indefinite, because "it is unclear how the watermark can help determine the speed at which the advertisement was played" (Ans. 3). The Appellants contend that one having ordinary skill in the art would understand what is recited in claims 5, 15, and 25 when the claims are read in light of the Specification (App. Br. 12; Reply Br. 2). The issue before us is whether those skilled in the art would understand what is claimed when the claim is read in light of the Specification.

The Appellants contend that Rodriguez does not anticipate claims 1-7, 9, 11-17, 19, 27, and 28 because it does not disclose associating an indication that an advertisement was played with an identifier for a particular user (App. Br. 13; Reply Br. 3). The Examiner found that this step is implicitly taught or supported in Rodriguez (Ans. 6).

The Appellants further contend that Rodriguez does not anticipate claims 21-26, 29, and 30, because it does not disclose a watermark detector to detect an advertisement including a watermark and control operation of a media player in response to detection of the watermark (App. Br. 13). The Examiner found that Rodriguez discloses controlling the media player such that the entire watermarked advertisement is heard or consumed without the user's interruption (Ans. 7). The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-7, 9, 11-17, 19, and 21-30 under 35 U.S.C. § 102(e) as anticipated by Rodriguez.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Rodriguez discloses using watermarks as a mechanism for confirming receipt of content (Rodriguez, col. 57, ll. 18-19).
2. Rodriguez describes that a content receiving device (e.g., computer, television or set-top box, audio appliance, etc.)

periodically decodes a watermark from the received content to confirm its continued reception. When a changed watermark is detected (i.e., reception of a different content object begins), the duration of the previously-received content is logged, and a receipt is issued (Rodriguez, col. 57, ll. 25-34).

3. Rodriguez discloses that an application of this technology is in advertising verification that allows the duration of the advertising impression to be precisely tracked (Rodriguez, col. 57, l. 65 – col. 58, l. 8).

4. Rodriguez discloses one embodiment in which viewers are provided incentives for viewing advertising in its entirety. In this embodiment, a content-receiving device includes a watermark detector that issues a receipt for each advertisement that it is heard/viewed in its entirety. The receipts can be redeemed for content tokens, monetary value, etc. (Rodriguez, col. 58, ll. 9-28).

5. As such, Rodriguez discloses monitoring a watermark included with an advertisement and accruing a credit after determining that the advertisement was played.

6. Rodriguez does not disclose, however, that the system has any way of identifying the particular recipient viewing the advertisement, and thus it does not disclose, either explicitly or inherently, associating an indication that an advertisement was played with an identifier for a particular user.

7. Rather, Rodriguez appears to disclose that the system issues the receipt so long as the advertisement has been played in its entirety regardless of who has viewed the advertisement.
8. Further, although Rodriguez discloses a watermark detector to detect a watermark included with an advertisement, it does not disclose that the watermark detector controls operation of a media player in response to detection of the watermark.
9. Rather, Rodriguez appears to disclose that the watermark detector detects a watermark included with an advertisement and then passively monitors whether a recipient views the advertisement in its entirety. If the advertisement is viewed in its entirety, the watermark detector issues a receipt (Rodriguez, col. 58, ll. 11-13).

PRINCIPLES OF LAW

35 U.S.C. § 112, second paragraph

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.,* 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

Rejection of claims 5, 15, and 25 under 35 U.S.C. § 112, second paragraph

The Examiner found that claims 5, 15, and 25 are indefinite, because "it is unclear how the watermark can help determine the speed at which the advertisement was played" (Ans. 3).

Claim 5 further defines the monitoring a watermark step of claim 1 and recites that this step includes "determining that the advertisement was played at a predetermined speed."

Claim 15 further defines the instructions stored on the medium of claim 11 to include an instruction "to determine that an advertisement was played at a predetermined speed."

Claim 25 further defines the function of the watermark detector of claim 21 to determine "whether an advertisement was played at a predetermined speed."

The Appellants' Specification describes a watermark detector that detects whether watermarked material is played in full at the predetermined play speed and is not otherwise muted, masked, fast-forwarded or stripped from the content (Spec. 4:8-15). The Specification further describes that the determination that the commercial was played correctly may be based on stored, predetermined characterizing information for all or a variety of commercials (Spec. 7:11-14). For example, it may be known that all commercials have a predetermined speed and a predetermined duration, or

the watermark detector may access a database to determine the characteristics of a given commercial and then compare that information to what is actually detected (Spec 7:14-22). It is clear from the Appellants' Specification that it is the watermark detector that is capable of determining whether a watermarked advertisement is played at the proper speed. The claims do not recite that the watermark itself determines the speed at which the advertisement was played, as contended by the Examiner.

Thus, we find that one having ordinary skill in the art would understand what is claimed when the claims are read in light of the Specification. Accordingly, we will not sustain the rejection of claims 5, 15, and 25 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Rejection of claims 1-7, 9, 11-17, 19, and 21-30 under 35 U.S.C. § 102(e)

Independent claims 1 and 11 recite associating an indication that an advertisement was played with an identifier for a particular user. As we found *supra*, Rodriguez does not disclose that the system has any way of identifying the particular recipient viewing the advertisement, and thus it does not disclose, either explicitly or inherently, associating an indication that an advertisement was played with an identifier for a particular user (Facts 1-6). Rather, Rodriguez appears to disclose that the system issues a receipt so long as the advertisement has been played in its entirety regardless of who has viewed the advertisement (Fact 7). As such, Rodriguez does not anticipate independent claims 1 and 11 or their dependent claims 2-7, 9, 11-17, 19, 27, and 28.

Independent claims 21, 29, and 30 recite a watermark detector that detects a watermark included with an advertisement and controls operation of a media player in response to detection of the watermark. As we found *supra*, although Rodriguez discloses a watermark detector to detect a watermark included with an advertisement, it does not disclose that the watermark detector controls operation of a media player in response to detection of the watermark (Fact 8). Rather, Rodriguez appears to disclose that the watermark detector detects a watermark included with an advertisement, passively monitors whether a recipient views the advertisement in its entirety, and if so, issues a receipt (Fact 9). We did not find any disclosure in Rodriguez that the media player is configured to prevent the user's interruption of the advertisement being played once the watermark detector detected the presence of a watermark, as asserted by the Examiner. As such, Rodriguez does not anticipate independent claims 21, 29, and 30 or their dependent claims 22-26.

CONCLUSIONS OF LAW

We conclude the Appellants have shown that the Examiner erred in rejecting claims 5, 15, and 25 under 35 U.S.C. § 112, second paragraph and claims 1-7, 9, 11-17, 19, and 21-30 under 35 U.S.C. § 102(e) as anticipated by Rodriguez.

DECISION

The decision of the Examiner to reject claims 1-7, 9, 11-17, 19, and 21-30 is reversed.

REVERSED

vsh

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